

### **REMARKS**

Claims 1-58 are pending in the instant application. Applicants request amendment of claims 2-10, 12-21, 23-24, 26-30, 35, 37, 42-50, 52-53 and 58 according to the Listing of Claims above. Upon entry of the present Amendment, claims 1-58 will be pending in the application. Applicants have not requested cancellation of any claims. Although claims to unelected invention(s) may be deemed withdrawn, Applicants respectfully request that cancellation of any such claims be held in abeyance until allowable subject matter has been determined. While Applicants have elected a species, upon a determination of the patentability of that species, corresponding generic claims may be rejoined. Applicants wish to preserve the right to rejoinder of the withdrawn claims with the elected claims. *See*, M.P.E.P. § 821.04 ("Treatment of Claims Held To Be Drawn to Nonelected Inventions. Rejoinder.").

Amendment of the claims herein should in no way be construed as acquiescence to any of the rejections/objections set forth in the instant Office Action, or in any previous Office Action, and were done solely to expedite prosecution of the above-identified application. Applicants reserve the option to prosecute the same or similar claims as those originally filed in the instant application or one or more or subsequent applications. No new matter has been added.

### ***Restriction Requirement***

The Examiner has required restriction to one of the following inventions under 35 U.S.C. §121, as set forth in the Office Action mailed July 24, 2003:

- I. Claims 1-10, 25, 11-18, 32, 41-47, 58 drawn to products and their compositions.
- II. **Claims 19, 26, 48, drawn to method of inhibiting ICE *in vivo*.**
- III. Claims 20, 27, 49, drawn to method of inhibiting caspase *in vivo*.
- IV. Claims 21, 28, 50, drawn to method of treating or preventing stroke.

- V. Claims 22-24, 29-31, 51-53, drawn to method of treating inflammatory diseases.
- VI. Claims 33, 34, 54, drawn to method of treating septic shock.
- VII. Claims 35, 36, 55, drawn to method of treating reperfusion injury.
- VIII. Claims 37, 38, 56, drawn to method of treating Alzheimer's disease.
- IX. Claims 39, 40, 56 [*sic*, presumably "57"], drawn to method of treating shigellosis.

Applicants hereby elect the invention of Group II (Claims 19, 26, and 48) for prosecution in this application. Applicants, however, elect Group II under protest and traverse the present Restriction Requirement.

The various therapeutic methods of Groups IV-IX are directed to the treatment or prevention of certain diseases and conditions by targeting a common biological pathway. In particular, the methods of treatment set forth in Groups IV-IX are related by the modulation of a common biological pathway by the interleukin-1 $\beta$  converting enzyme inhibitors of the present invention, *i.e.*, administration of these compounds to a patient will inherently treat these diseases. The claims have thus been amended to illustrate that the claims of Groups IV-IX are subgeneric to the claims of Group II (the elected group). Applicants submit that the methods of Groups IV-IX are not mutually exclusive, and therefore restriction is improper. Applicants further note that the compounds that are recited in the claimed methods have been allowed and issued in U.S. Patent No. 6,316,415 (of which this is a divisional application).

The Examiner has further required election of a single species to serve as a basis for an initial search during examination on the merits. Applicants hereby elect the species in Example 4e (*see* page 28, lines 18-20 of the specification), namely the compound "3-(2{2-[2-acetylamino-3-(4-hydroxy-phenyl)-propionylamino-]4-carboxy-butyrylamino}-3-methyl-butyrylamino)-5-(7,7-dimethyl-2-oxo-bicyclo[2.2.1]hept-1-ylmethanesulfonylamino)-4-oxo-pentanoic acid." All of the elected claims read on this elected species. Inasmuch as the elected species *per se* has been found to be allowable in the parent of this

Application No.: 09/964114, filed September 25, 2001  
Response filed November 24, 2003  
Responsive to Restriction Requirement of July 24, 2003

Examiner: Michael Borin  
Group Art Unit: 1631  
Docket No.: BBI-5035CPUSDV

divisional application, *see*, U.S. Patent No. 6,316,415, Applicants respectfully request that the generic claims reading thereon also be allowed, along with dependent claims to additional species as provided by 37 C.F.R. § 1.141.

Applicants believe that no fee is due with this Response other than a fee for a three-month extension of time, payment of which is authorized in the enclosed Request for a extension of time. Applicants hereby request any extension of time that may be required to enter this Response. If any fee is due in this case, then please charge our Deposit Account No. 12-0080, under Order No. BBI-5035CPUSDV from which the undersigned is authorized to draw.

Dated: \_\_\_\_\_

*November 27, 2003*

Respectfully submitted,

By \_\_\_\_\_

Theodore R. West

Registration No.: 47,202

LAHIVE & COCKFIELD, LLP

28 State Street

Boston, Massachusetts 02109

(617) 227-7400

(617) 742-4214 (Fax)

Attorney/Agent for Applicant